

DOCKET NO.: BELL-0061/00230
Application No.: 09/734,818
Office Action Dated: November 21, 2003

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS/ARGUMENTS

In response to the Office Action dated November 21, 2003, Applicant respectfully requests reconsideration based on the above claim amendment and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claim Status

Claims 1-39 are pending. Claims 36-39 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1, 13, 17, 30 and 36-39 stand rejected under 35 U.S.C. § 112, first paragraph.

Claims 1, 5-8, 17, 19, 20, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,778,052 to Rubin et al., hereinafter "Rubin," in view of U.S. Patent No. 5,463,677 to Bash et al., hereinafter "Bash." Claims 2, 3, 18, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rubin in view of Bash and further in view of U.S. Patent No. 6,411,684 to Cohn et al., hereinafter "Cohn." Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rubin in view of Bash and further in view of U.S. Patent No. 6,418,306 to McConnell et al., hereinafter "McConnell." Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rubin in view of Bash and further in view of U.S. Patent No. 6,411,704 to Pelletier et al., hereinafter "Pelletier." Claims 10-12 and 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rubin in view of Bash and further in view of U.S. Patent No. 5,396,542 to Alger et al., hereinafter "Alger." Claims 13, 15, 16, 30, 31, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McConnell in view of U.S. Patent No. 6,009,321 to Wang et al., hereinafter "Wang" and further in view of Bash. Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McConnell in view of Wang and further in view of Walsh. Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rubin in view of Bash and further in view of U.S. Patent No. 6,442,250 to Troen-Krasnow et al., hereinafter "Troen-Krasnow." Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McConnell in view of Bash and further in view of Troen-Krasnow. Claims 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McConnell in view of Bash and further in view of Rubin.

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Claims 1, 13, 17, and 30 have been amended. No new matter has been added. Support for the amendment can be found in the specification as originally filed at least at page 12, lines 3-4 and page 14, line 17. Claims 36-39 have been canceled and their features incorporated into their respective independent claims.

Applicant respectfully traverses the grounds for rejection and requests reconsideration and withdrawal of the rejections of claims 1-35 in view of the following.

Related Case

Applicant wishes to notify the examiner of a potentially related co-pending case filed on December 12, 2000, serial number 09/734,981.

Rejections Under 35 U.S.C. § 112

The examiner has rejected claims 36-39 alleging that “the billed party” has no antecedent basis. Claims 1, 13, 17, and 30 (which now include the features of dependent claims 36-39, respectively) include the feature of “the calling party is billed for delivering said message to said called party.” As such, applicant respectfully requests reconsideration and withdrawal of this rejection.

The examiner has rejected claims 1, 13, 17, and 30 alleging that there is no support in the specification for “permission to *leave* the message” versus permission to *send* the message. (emphasis added) Support can be found in the specification as originally filed at least at page 12, lines 27-28 which states that the calling party may choose to either leave a message or to end the call processing. As such, applicant respectfully requests reconsideration and withdrawal of this rejection.

The examiner has rejected claims 1 and 13 for including the features of “deliver said message to said called party responsive to a request from said called party if one of said service node and said first service switching point receives permission to leave a message from said telephone with said calling line number” alleging no support in the specification. The examiner argues that the specification does not disclose delivering said message on condition if one of said service node and said first service switching point receives permission to leave a message from said telephone with said calling line number (emphasis in office action). The claims, however, includes the feature of delivering the message

responsive to the called party (emphasis added). The examiner agrees that this is supported at page 14, lines 14-23 of the specification as originally filed. Applicant submits that the remaining feature is supported in the specification as originally filed at page 12, lines 30-31 which states that if the calling party selects not to leave a message, call processing ends. As such, applicant respectfully requests reconsideration and withdrawal of the rejections of claims 1 and 13 under 35 U.S.C. § 112.

Rejections Under 35 U.S.C. § 103

Independent Claims 1, 13, 17, and 30

Independent claims 1, 13, 17, and 30 each include features that are neither disclosed nor suggested by the cited references, either taken alone or in combination, namely as represented by claim 1:

1. (Currently Amended) A system for receiving a message from a calling party associated with a telephone with a calling line number associated with a first service switching point and providing said message to a called party associated with a telephone with a called line number, comprising:

a second service switching point connected to said telephone with said called line number, said second service switching point comprising a trigger responsive to a busy status on said called line number and said called line number is not subscribed to any voice messaging system;

a signal transfer point adapted to communicate with said second service switching point;

a service control point adapted to communicate with said signal transfer point, said service control point containing a database; and

a service node connected to said second service switching point through a first data link, and connected to said service control point through a second data link;

*wherein said second service switching point sends a query to said service control point responsive to said trigger, said service control point commands one of said service node and said first service switching point to prompt for permission to leave a message from said telephone with said calling line number, said service node is adapted to receive said message from said calling party into a voice messaging system when said called line number has a busy status, store said message, and deliver said message to said called party responsive to a request from said called party if one of said service node and said first service switching point receives permission to leave a message from said telephone with said calling line number, and ***wherein the calling party is the billed party.*** (emphasis added)*

Claims 1, 13, 17, and 30 are directed to delivering a message to a called line number using a trigger responsive to a busy status on the called line number even though the called line number is not subscribed to any voice messaging system and *the calling party is billed* for the service. The trigger is set on the service switching point (the second service switching point) of the *called* line.

The examiner concedes that Rubin does not teach the “called line number is not subscribed to any voice messaging system.” As such, the examiner relies on Bash for disclosing this feature. Bash discloses that the called party may receive the message if the called party is willing to *pay collect* for the message (c. 1, ll. 44-46). Therefore, assuming *arguendo* that there is some motivation to combine Rubin and Bash, such combination would not result in claim 1. Rather, such combination would still require the called party to pay for receiving the message. In contrast, claim 1 allows the calling party to pay for delivering the message to the called party.

In rejecting claim 36 (which recited that the calling party is the billed party), the examiner took official notice that it is known to bill the calling party for telephone services. However, applicant believes that the office action failed to establish a *prima facie* case of obviousness. “The prior art must provide a motivation or reason for the worker in the art, *without the benefit of [applicant’s] specification*, to make the necessary changes in the reference device.” *M.P.E.P.* § 2144.04 (citing *Ex parte Chicago Rawhide Manufacturing Co.*, 223 U.S.P.Q. 351, 353 (Bd. Pat. App. & Inter. 1984) (emphasis added). In particular, “[a] critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.” *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). “The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (quoting *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1138 (Fed. Cir. 1985). To establish a *prima facie* case of obviousness, “there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant.” *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998). “In other words, the examiner must show *reasons* that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention,

would select the elements from the cited prior art references for combination in the manner claimed.”(emphasis added) *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Here, applicant respectfully asserts that none of the cited references nor those aspects well known to those skilled in the art would provide specific guidance that would lead one of ordinary skill in the art to the claimed features. At best the examiner’s statement that “[i]t would have been obvious to one skilled at the time of the invention was made to modify Rubin and Bash to have the calling party is the billed party such that the modified system of Rubin and Bash would be able to support billing to the calling party” is conclusory. Alternatively, it could be considered circular logic. The examiner appears to be saying that the motivation to bill the calling party is to bill the calling party. Moreover, the examiner has not considered the placement of the trigger in connection with the billing. A simple conventional method of billing is to perform the billing based on the trigger. The claims, however, include the feature of billing a different party than the one that has the trigger set on their SSP. The examiner has not considered this at all. Therefore, the Office Action failed to establish a *prima facie* case of obviousness.

Accordingly, applicant submits that the cited references, either taken alone or in combination, do not provide a motivation or suggestion that results in the features of independent claims 1, 13, 17, and 30. Additionally, inasmuch as dependent claims 2-12, 14-16, 18-29, and 31-35 (which have also been rejected) are dependent on claims 1, 13, 17, or 30, these claims are patentable over the cited reference, at least by virtue of their dependency. Accordingly, applicant respectfully requests reconsideration and withdrawal of the rejections of claims 1-35 under 35 U.S.C. § 103(a).

Conclusion

For all the foregoing reasons, applicant respectfully submits that the present application is now in condition for allowance. Reconsideration of the Office Action and an early Notice of Allowance are respectfully requested. In the event that the examiner cannot allow the present application for any reason, the examiner is encouraged to contact the undersigned attorney, Raymond N. Scott Jr. at (215) 564-8951, to discuss resolution of any remaining issues.

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Raymond N. Scott, Jr.
Attorney for Applicant
Registration No. 48,666

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439